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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,923	09/09/2003	Frank C. Kohn	17396/09156	2292

27530 7590 02/22/2007  
NELSON MULLINS RILEY & SCARBOROUGH, LLP  
1320 MAIN STREET, 17TH FLOOR  
COLUMBIA, SC 29201

EXAMINER
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PRYOR, ALTON NATHANIEL

ART UNIT	PAPER NUMBER
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1616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/658,923

Applicant(s)

KOHN, FRANK C.

Examiner

Alton N. Pryor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,13,14,17 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3,6-12,15,16,18-20 and 22-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

- I. Rejection of claims 24 and 25 under 35 USC 112, 2<sup>nd</sup> paragraph will not be maintained in light of amendment filed 11/13/06. Applicant has corrected the antecedent basis problem in claims with regard to "insect".
- II. Rejection of claims 1-3,6-12,15,16,18-20,22-37 under 35 USC 112, 1<sup>st</sup> paragraph will maintained in light of amendment filed 11/13/06. The specification does not set forth examples of additional pesticide compounds that can be employed in the instant application.
- III. Rejection of claims under obviousness-type double patenting with respect to USPNs 6660690 and 6903093 will not be maintained in light of amendment filed 11/13/06. Applicant has filed terminal disclaimer.
- IV. Rejection of claims under provisional obviousness-type double patenting with respect to USANs 11/072215 and 11/028782 will be maintained in light of amendment filed 11/13/06. Applicant's willingness to consider the filing a terminal disclaimer at a later time is acknowledged.
- V. Rejection of claims under obviousness-type double patenting with respect to USPN 6713077 will be maintained in light of amendment filed 11/13/06 for reason on record and reason as follows. Applicant argues that USPN '077 does not suggest the addition of a pesticide to the permethrin. Examiner points applicant to column 5 lines 24-30 of USPN '077 where it lists suitable pesticides that can be added to the permethrin.
- VI. New Rejection

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6,25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gatehouse et al (Pesticide Science, 1982, vol. 13 no. 2, 109-18) and Maskell et al (Chemical control of wheat bulb fly attacking winter wheat in eastern England, Annals of Applied Biology, 1986, 109 (2), 223-236). Gatehouse teaches a method of applying permethrin (pyrethroid) to seed of winter wheat crops to protect wheat from becoming damaged by wheat bulb fly larvae (pests). Method results in the seed being treated with permethrin, which is also protected from becoming damaged by said pests. See abstract. Permethrin is a synthetic pyrethroid, which has a vapor pressure that is lower than that of tefluthrin. See instant claim 2. Gatehouse does not teach the invention comprising additional pesticide. The reference does not teach the control of cutworm damage. The reference abstract is silent to rate of application rate of permethrin to seed (application rate equal to or greater than 88g of permethrin per 100 kg seed). However, Maskell teaches a method of applying pyrethroid compositions comprising a synthetic pyrethroid and an organophosphate (additional pesticide) to seed of winter wheat crops to protect wheat from becoming damaged by wheat bulb fly (pests). Method results in the seed being treated with synthetic pyrethroid and organophosphate, which is also protected from becoming damaged by said pests. See abstract. It would have been

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obvious to one having ordinary skill in the art to combine Maskell and Gatehouse to arrive at elected invention comprising permethrin and organophosphate. One would have been motivated to do this since each invention individually teach a method of controlling wheat bulb fly in wheat. Note both instant invention and prior art discloses the same active step, i.e., application of permethrin or synthetic pyrethroid to seed. It is obvious that the same benefit acquired in Applicant's (control of cutworms) would have been effective in Gatehouse's and Maskell's invention. One would have expected this since prior art and instant inventions teach the application of permethrin (or synthetic pyrethroid) to wheat seeds. It is obvious that one having ordinary skill in the art would have been expected to determine optimum application rate of permethrin or synthetic pyrethroid to seed. One would have been motivated to do this in order to determine what application rate is effective at controlling pests while at the same time promoting healthy plant (wheat) growth. It is possible that artisan would have discovered that instant application rate is most effective. Where the provide teaches all claim limitations with the exception of a defined application rate as instantly claimed applicant must present a showing of the criticality of the application rate claimed.

#### ***Election Status***

Elected invention comprising permethrin is no allowable. See rejection above.

#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alton Pryor  
Primary Examiner  
AU 1616